

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Alain FOUERE et al.

Confirmation No.: 4885

Appln. No. : 10/787,170

Group Art Unit : 3746

Filed : February 27, 2004

Examiner : P. Bianco

For : LACRYMAL PLUGS AND METHODS FOR SETTING SAME

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Window, Mail Stop **AF**
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir :

This request is being filed concurrently with a Notice of Appeal and is responsive to the Final Official Action of May 19, 2006.

While no fees are believed necessary to ensure consideration of the instant Request, should any fees be deemed necessary, the undersigned authorizes the charging of any necessary fees, including any extensions of time fees required to place the application in condition for allowance by Examiner's Amendment, to Deposit Account No. 19 - 0089 in order to maintain pendency of this application.

Reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) is respectfully requested in view of the following remarks.

A prima facie case of anticipation has not been set forth, such that the Rejection Under 35 U.S.C. § 102(b) is improper. Moreover, a prima facie case of obviousness has not been set forth, such that the Rejection Under 35 U.S.C. § 103(a) is also improper.

Examiner's Assertion:

WEBB et al. (U.S. Patent No. 6,629,533) [hereinafter "WEBB"] discloses a punctum plug and method for inserting the same, in which the punctum plug includes one or more flexible anchoring arms "flexible enough to fold during insertion and then straighten out once in place"

Applicant's Reply:

The Examiner's interpretation of WEBB's disclosure is based upon Applicant's disclosure and not upon any specific teaching in WEBB. That is, while Applicants acknowledge WEBB's disclosure of a flexible head and flexible anchoring arms, there is no teaching, either expressly or impliedly, that the anchoring arms of WEBB are structured and arranged to *straighten out when positioned* to maintain the lachrymal plug in place, as recited in at least independent claims 1 and 19.

In this regard, while disclosing it "should be appreciated that each of the arms is sufficiently flexible such that the arms will fold upward toward the head during insertion and will accommodate even unusually narrow punctal openings," (WEBB, col. 4, line 67 – col. 5, line 3), Applicants submit WEBB fails to provide any disclosure as to the positioning of the flexible anchoring arms after the punctum plug is inserted. Moreover, Applicants further note WEBB's disclosures the punctum plug properly fits within a variety of puncta sizes and/or a portion of the anchoring arm should extend a distance greater than the width of the head, fails to provide any teaching or even an arguable suggestion that, once

positioned, the arms *straighten out*, as recited in at least independent claims 1 and 19.

Because WEBB fails to show at least the above-noted features of at least independent claims 1 and 19, Applicants submit the Examiner has failed to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 102(e), and that the present rejection is improper and should be withdrawn.

Accordingly, Applicant requests the Examiner's decision to finally reject independent claims 1 and 19, as well as dependent claims 2 – 9, 11, 18, and 20 be withdrawn and the application be returned to the Examiner for allowance.

Examiner's Assertion:

WEBB discloses a punctum plug and method for inserting the same, in which the "anchoring arms are seen to be equivalent to applicants pins, since they extend radially outward from the body in a helical formation."

Applicant's Reply:

The Examiner's interpretation of WEBB's disclosure is again based upon Applicant's disclosure and not upon any specific teaching in WEBB. Moreover, Applicants submit WEBB fails to provide any arguable teaching of the expressly recited radial pins of at least claims 2 - 9.

Applicants initially submit, as the Examiner's rejection of claims 2 – 9 is based upon a theory of equivalence, which is an issue of obviousness under 35 U.S.C. § 103(a), such that the Examiner's arguments are inapplicable to the rejection of record. Accordingly, Applicants submit the Examiner has not provided any basis for rejecting claims 2 – 9 under 35 U.S.C. § 102(b), and no rejection of claims 2 – 9 has been made under 35 U.S.C. § 103(a).

Applicants' further submit the assertion that radial pins are seen as equivalents of the flexible anchoring arms of WEBB is merely the Examiner's unsubstantiated opinion based upon a review of Applicants' disclosure and claims, i.e., the Examiner has not shown any disclosure in WEBB or any

document of record to arguably assert the art of record "sees" the flexible anchoring arms of WEBB as equivalent to pins.

Accordingly, Applicant requests the Examiner's decision to finally reject claims 2 – 9 be withdrawn and the application be returned to the Examiner for allowance.

Applicant's Assertion:

No proper combination of WEBB *with any of MacKEEN, FREEMAN, HERRICK, or SEDER* renders the instant invention unpatentable under 35 U.S.C. § 103(a). For the reasons set forth above, Applicants submit neither WEBB nor any of the applied secondary documents provide any teaching or suggestion for flexible anchoring arms structured and arranged to *straighten out when positioned* to maintain the lachrymal plug in place, as recited in at least independent claims 1 and 19.

Moreover, Applicants note the Examiner has not pointed to any specific teaching within the art of record to even arguably support his assertions that at least the above-noted feature of the invention is expressly or impliedly disclosed or even arguably suggested.

Because none of the applied documents of record provide any teaching or suggestion of at least the above-noted feature of at least independent claims 1 and 19, Applicants submit that no proper combination of these documents can even arguably render unpatentable the instant invention.

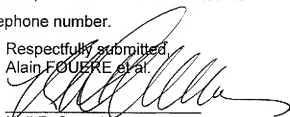
Accordingly, Applicant requests the Examiner's decision to finally reject each pending claim be withdrawn and the application be returned to the Examiner for allowance.

CONCLUSION

Reconsideration of the Final Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Alain FOUERE et al.



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November 20, 2006
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